

1 I. Neel Chatterjee (SBN 173985)
2 nchatterjee@orrick.com
3 Fabio E. Marino (SBN 183825)
4 fmarino@orrick.com
5 Monte M.F. Cooper (SBN 196746)
6 mcooper@orrick.com
7 Qudus B. Olaniran (SBN 267838)
8 qolaniran@orrick.com
9 ORRICK, HERRINGTON & SUTCLIFFE LLP
10 1000 Marsh Road
11 Menlo Park, CA 94025
12 Telephone: 650-614-7400
13 Facsimile: 650-614-7401
14 Benjamin J. Hofileña (SBN 227117)
15 bhofilena@orrick.com
16 Alyssa M. Caridis (SBN 260103)
17 acaridis@orrick.com
18 ORRICK, HERRINGTON & SUTCLIFFE LLP
19 777 South Figueroa Street, Suite 3200
20 Los Angeles, CA 90017
21 Telephone: 213-629-2020
22 Facsimile: 213-612-2499
23 Attorneys for Defendant and Counterclaimant
24 iBAHN CORPORATION

25 [SEE SIGNATURE PAGE FOR A COMPLETE
26 LISTING OF COUNSEL FOR DEFENDANTS]

27 IN THE UNITED STATES DISTRICT COURT
28 FOR THE CENTRAL DISTRICT OF CALIFORNIA
1 WESTERN DIVISION

2 NOMADIX, INC.,
3 Plaintiff,
4 v.
5 HEWLETT-PACKARD COMPANY, et
6 al.,
7 Defendants.

8 AND RELATED COUNTERCLAIMS

9 Case No. CV-09-08441 DDP (VBKx)

10 **DEFENDANTS' ANSWERING
11 CLAIM CONSTRUCTION BRIEF**

12 Hearing May 19, 2011
13 Date: 9:00 a.m.
14 Time:

15 Honorable Dean D. Pregerson

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2	Ex. 3 No.	4 Description	5 Abbreviation
6	1	U.S. Patent No. 6,130,892 issued Oct. 10, 2000 (Short et al.)	7 '892 Patent
8	2	U.S. Patent No. 7,088,727 issued Aug. 8, 2006 (Short et al.)	9 '727 Patent
10	3	U.S. Patent No. 7,554,995 issued Jun. 30, 2009 (Short et al.)	11 '995 Patent
12	4	U.S. Patent No. 6,857,009 issued Feb. 15, 2005 (Ferreria et al.)	13 '009 Patent
14	5	U.S. Patent No. 6,636,894 issued Oct. 21, 2003 (Short et al.)	15 '894 Patent
16	6	U.S. Patent No. 7,194,554 issued Mar. 20, 2007 (Short et al.)	17 '554 Patent
18	7	U.S. Patent No. 7,689,716 issued Mar. 30, 2010 (Short et al.)	19 '716 Patent
20	8	U.S. Patent No. 6,868,399 issued Mar. 15, 2005 (Short et al.)	21 '399 Patent
22	9	May 16, 2007 Reply to Final Office Action re reexamination of U.S. Patent No. 6,130,892, Serial No. 90/007,423	23 05/16/07 '892 RE ROA
24	10	Apr. 1, 2009 Record of Oral Hearing re reexamination of U.S. Patent No. 6,130,892, Serial No. 90/007,423	25 04/01/09 '892 RE ROH
26	11	Apr. 22, 2004 Office Action re U.S. Patent No. 7,088,727	27 04/22/04 '727 OA
28	12	Mar. 9, 2006 Amendment and Response to Office Action re U.S. Patent No. 7,088,727	29 03/09/06 '727 ROA
1	13	Apr. 4, 2005 Request for Continued Examination and Amendment re U.S. Patent No. 7,088,727	3 '04/05 '727 RCE and Amdt.
2	14	Oct. 5, 2005 Office Action re U.S. Patent No. 7,088,727	4 10/05/05 '727 OA
3	15	May 6, 2003 Amendment and Response to Office Action re U.S. Patent No. 6,636,894	5 05/06/03 '894 ROA
4	16	Dec. 13, 2004 Response to Office Action re U.S. Patent No. 7,194,554	6 12/13/04 '554 ROA
5	17	Feb. 11, 2005 Amendment and reply to Office Action re U.S. Patent No. 7,194,554	7 02/11/05 '554 ROA
6	18	Apr. 15, 2005 Office Action re U.S. Patent No. 7,194,554	8 04/15/05 '554 OA

1	19	Dec. 21, 2005 Office Action re U.S. Patent No. 7,194,554	12/21/05 '554 OA
2	20	May 26, 2006 Office Action re U.S. Patent No. 7,194,554	05/26/06 '554 OA
3	21	Oct. 17, 2005 Amendment and Response to Office Action re U.S. Patent No. 7,194,554	10/17/05 '554 ROA
4	22	Mar. 21, 2006 Preliminary Amendment and Response to Office Action Response re U.S. Patent No. 7,194,554	03/21/06 '554 ROA
5	23	Nov. 28, 2006 Notice of Allowability re U.S. Patent No. 7,194,554	11/28/06 '554 Notice of Allowability
6	24	Nov. 7, 2003 Amendment and Response to Office Action re U.S. Patent No. 6,868,399	11/07/03 '399 ROA
7	25	Dec. 9, 2002 Amendment and Response to Office Action re U.S. Patent No. 6,868,399	12/09/02 '399 ROA
8	26	Aug. 27, 2002 Office Action re U.S. Patent No. 6,868,399	08/27/02 '399 OA
9	27	David A. Maltz and Pravin Bhagwat, TCP Splicing for Application Layer Proxy Performance	IBM Research Paper
10	28	Plaintiff's Opening Claim Construction Brief, <i>Nomadix, Inc. v. Second Rule LLC</i> , No. 2:07-cv-01946-DDP-VBK (C.D. Cal.) (filed Aug. 4, 2008)	Nomadix's Op. Br.
11	29	Defendant's Opening Claim Construction Brief, <i>Nomadix, Inc. v. Second Rule LLC</i> , No. 2:07-cv-01946-DDP-VBK (C.D. Cal.) (filed Aug. 4, 2008)	Second Rule Op. Br.
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13	31	Defendant's Reply to Plaintiff's Opening Claim Construction Brief, <i>Nomadix, Inc. v. Second Rule LLC</i> , No. 2:07-cv-01946-DDP-VBK (C.D. Cal.) (filed Aug. 22, 2008)	Second Rule Reply Br.
14	32	Amended Claim Construction Order, <i>Nomadix, Inc. v. Second Rule LLC</i> , No. 2:07-cv-01946-DDP-VBK (C.D. Cal.) (filed Oct. 15, 2008)	Second Rule Amended Claim Constr. Order
15	33	Exemplary Claims of the Patents-In-Suit	Exemplary Claims
16	34	U.S. Provisional Patent Application No. 60/111,497, filed on December 8, 1998.	12/08/98 '497 Appln.
17	35	Jun. 7, 2004 Amendment and Response to Office Action re U.S. Patent No. 7,088,727	06/07/04 '727 ROA
18	36	U.S. Patent No. 5,893,077 issued Apr. 6, 1999 (Griffin)	Griffin '077 Patent
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1	37	U.S. Patent No. 6,385,653 issued May 7, 2002 (Sitaraman)	Sitaraman '653 Patent
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1 **I. INTRODUCTION**

2 In the mid- to late 1990's, computer users began traveling more frequently with
3 laptop computers and accessing the Internet at hotels, coffee shops and other places
4 offering Internet access. However, a problem arose in that, in those days, a computer
5 was generally configured to communicate with a "home" network, *i.e.*, a network
6 found in the office or residence in which the computer was typically used. The
7 computer had to be manually reconfigured each time that it encountered a new
8 network (*e.g.*, at each new hotel or coffee shop). Manual configuration was not an
9 intuitive or easy task, particularly for people who were not trained in the computer
10 field. The purported invention of the Nomadix patents was a workaround that
11 eliminated the need for such manual reconfiguration.

12 The workaround claimed in the eight asserted Nomadix patents was not the
13 only way to avoid the problem of manual reconfiguration. The approach that the
14 mobile computing industry widely adopted was entirely different from the Nomadix
15 workaround and was actually based on alternative technology that existed at the time
16 of the purported invention. Underlying many of the claim construction disputes in
17 this case is Nomadix's attempt to broaden the scope of its claims to cover not only the
18 workaround that it developed but also the radically different technology that for many
19 years has been used in the mobile computer field. In so doing, Nomadix seeks to read
20 out the very solution to the manual reconfiguration problem that its patents originally
21 addressed. Nomadix's constructions, as a result, ignore clear teachings of the patents,
22 express definitions of the patentees, and disavowals made during prosecution.

23 This Court should reject Nomadix's invitation to ignore the words of the claims
24 that it wrote and the invention as characterized in the intrinsic evidence. Accordingly,
25 Defendants respectfully ask this Court to adopt Defendants' proposed constructions.¹

26 ¹ Per the instruction of this Court, the Defendants have cooperatively identified only
27 a limited number of terms to construe at this time, with the understanding that other
28 issues of claim construction or indefiniteness could be raised at a later time.
Defendants reserve the right to present further claim construction and/or

1 **II. THE TECHNOLOGY OF THE NOMADIX PATENTS-IN-SUIT**

2 **A. Introduction to Computer Networking**

3 Computers are typically connected to a local area network (“LAN”).
4 Generally speaking, a LAN consists of two or more computers that communicate
5 with each other in a limited geographical setting, such as a home or an office.
6 Computers on a LAN can communicate with one another, but to communicate with
7 other computers not on the LAN, *e.g.*, to communicate with computers on a
8 different LAN or to reach a website on the Internet, they must first send a message
9 through a “gateway.” A gateway is a special computer that connects networks
10 together and allows computers connected to different networks to talk to each other.
11 A gateway is located at the site of the LAN and relays messages through devices on
12 the Internet called “routers” so that each message can reach its intended destination.

13 For a computer to communicate with a gateway and with other computers not
14 on a LAN, two different types of addresses are typically used: a Media Access
15 Control (“MAC”) address and an Internet Protocol (“IP”) address. A MAC address
16 (*e.g.*, 00:A0:C9:14:C8:29) is a unique and permanent identifier that is provided to
17 each computer and gateway, typically at the time of manufacture. On the other
18 hand, an IP address (*e.g.*, 132.74.18.2) is used for communicating across networks
19 by indicating where the computer with a particular IP address is located and, thus,
20 allowing computers on other networks to send messages to that computer. At the
21 time that Nomadix began filing its patent applications, IP addresses were typically
22 “*static*” or effectively permanent.² If a new IP address was required, the computer
23 had to be manually reconfigured with that new IP address. *See, e.g.*, U.S. Patent

24
25 indefiniteness issues regarding these or other claim terms later in the case. Indeed,
26 the asserted claims are indefinite in numerous respects and the meaning of several
27 claims is impossible to divine. Defendants have here focused on only those terms
28 that are susceptible to construction.

² The application for the earliest Nomadix patent, U.S. Patent No. 6,130,892, was filed on March 12, 1998.

1 No. 6,130,892 (“’892 Patent”), Abstract.³

2 Computers communicate by sending messages to one another in discrete
3 bundles called “packets.” Conceptually, a packet is like a piece of mail. The
4 portion of the packet that may be thought of as the envelope contains, among other
5 things, the sending computer’s own MAC address and IP address, the IP address of
6 its intended recipient, and the MAC address of the sending computer’s gateway.
7 The packet also contains the actual data being transmitted, called a “payload.” The
8 payload’s analog is the letter inside an envelope.

9 To communicate with devices on another network, a computer sends a packet
10 to its gateway computer. The gateway then forwards the packet along, typically
11 through many intermediate routers, until the packet reaches its final destination. At
12 every step in the process, each intermediate router modifies the packet to include its
13 own MAC address and the MAC address of the next router in the path (to ensure
14 that the packet takes the correct next step). Once a packet reaches its intended
15 recipient, that recipient can respond and send packets back to the computer that
16 initiated the communication. Those packets will have, as a destination IP address,
17 the IP address of the original computer’s gateway. Such return packets will
18 likewise travel from router to router until they arrive back at the gateway for the
19 original computer. That gateway will then forward the packet to the computer
20 itself. The various routers through which inbound and outbound packets travel
21 contain tables that map IP addresses to MAC addresses. Using the IP addresses
22 contained in the packet, each router identifies the MAC address of the next router to
23 which to send the packet, ensuring that it ultimately arrives at its intended
24 destination.

25 ³ All exhibits cited in this brief are attached to the Declaration of Monte M.F.
26 Cooper (“Decl. of Cooper”) filed concurrently herewith. Additionally, for the
27 convenience of the Court, a list of exhibits with the abbreviations used throughout
28 this brief can be found after the Table of Authorities. The ’892, ’727, ’995, ’009,
’894, ’554, ’716, and ’399 patents are attached to the Decl. of Cooper as Exhibits 1-
8. All references to lines and column numbers in the patents are in the form “’892
patent at col(s).__:line(s) __.”

1 Thus, before a computer can send packets out on the Internet through a LAN,
2 it must have two things: (1) a proper IP address from which to send the packet (*i.e.*,
3 a proper return address) and (2) the MAC address of the LAN’s gateway (*i.e.*, a
4 proper address for the first recipient, which will then forward the packet on to the
5 next router in the chain). One way for a computer to obtain these two addresses is
6 for a person to manually configure the computer with IP address information. But,
7 as noted above, such manual configuration would have to take place every time the
8 computer moved from one network to another, and the average person would find
9 repeated manual configuration an onerous, if not impossible, task.

10 **B. The Computing Industry’s Solution to Manual Configuration**

11 In 1993, before the Nomadix patents were filed, the mobile computing
12 industry solved the manual reconfiguration problem in an elegant manner by
13 developing a standard called Dynamic Host Configuration Protocol, or DHCP.
14 DHCP is a technology that dynamically assigns a temporary IP address to each
15 computer for communication over a network. *See* U.S. Patent No. 7,088,727 (“727
16 Patent”) at 2 (citing Network Working Group Request for Comments: 1541
17 Dynamic Host Configuration Protocol (Oct. 1993)). Each time that a computer
18 using DHCP attempts to connect to a new network, the computer automatically
19 issues a DHCP request. A DHCP server on the network responds by doing two
20 pertinent things: (1) issuing the computer a temporary IP address to use on the
21 network and (2) providing the computer with the address of the network’s gateway
22 – called the “default gateway.” Thus, upon encountering a new network, a
23 computer using DHCP immediately obtains a dynamically assigned IP address that
24 is a proper source IP address for sending packets on that network and
25 simultaneously learns to where it should direct the packets that it would like to send
26 out onto the Internet. No manual configuration is ever required. At the time that
27 Nomadix filed its original patent applications, DHCP had been available but was
28 not commonly used. By the time that Windows 98 was released, DHCP had

1 become a routine component built into most computers.

2 **C. The Nomadix Workaround**

3 Even as the computing industry began widespread adoption of DHCP,
4 Nomadix expressly rejected it as an impractical universal solution to the “manual
5 configuration” problem. *See* Ex. 34 Attachment A at 7 [12/08/98 '497 Appln.],
6 (“The DHCP approach is too costly and complex to be deployed at the customer
7 premises.”). Instead, Nomadix developed and patented a different approach. *See*,
8 *e.g.*, '892 Patent at 12:31-40; '727 Patent at 12:43-52; U.S. Patent No. 7,554,995
9 (“995 Patent”) at 12:57-67 (distinguishing DHCP from the purported Nomadix
10 invention). Nomadix’s approach allowed a mobile computer to keep the static IP
11 address assigned to it on the network to which it typically was connected (which the
12 Nomadix patents call the “home” network). When the computer sent out packets
13 on the new network (*i.e.*, the “foreign network), the packets (1) would have a static
14 IP address that would not make sense on the “foreign” network; and (2) would be
15 directed to the MAC address of the gateway on the “home” network, not to the
16 default gateway of the “foreign” network. Without Nomadix’s proposed solution,
17 the new network would simply ignore these packets and efforts to communicate
18 would fail. To prevent a statically configured device from being ignored, Nomadix
19 introduced a special device (generally referred to in the early Nomadix patents as a
20 “nomadic router” or in the later patents as simply the “gateway device”) that resides
21 between the computer and the first new network to which the computer is
22 connected.

23 The nomadic router “intercepts” the packets sent out by a statically
24 configured computer and tricks the computer into thinking that – even though it has
25 moved – it is still on its “home” network. *See, e.g.*, '892 Patent, Abstract (“The
26 router automatically and transparently re-configures the terminal to its new location
27 and processes outgoing and incoming data. The router includes a processor which
28 appears as the home network to the terminal, and appears as the terminal to the

1 communication system . . .”).⁴ The nomadic router modifies the outbound packets
2 transmitted by the computer so that the gateway on the “foreign” network will not
3 ignore them, and when other computers (*e.g.*, out on the Internet) send back
4 responses, the gateway will deliver any response to the nomadic router, which will
5 then ensure that the original computer receives them.

6 Nomadix later modified the nomadic router to add a number of other features
7 for managing these network connections, such as redirection services to control
8 network access and a billing module to track a device’s access and use of the
9 network. *See, e.g.*, ’892 Patent at Figs. 1-3; U.S. Patent No. 6,636,894 (“’894
10 Patent”) at Fig. 1; U.S. Patent No. 6,868,399 (“’399 Patent”) at Fig. 2.

11 **III. ARGUMENT**

12 The eight patents in suit roughly break down into three different categories:
13 (1) the Transparent Router Patents, (2) the Transparent Redirection Patents, and (3)
14 the Transparent Billing Patent. For each group of patents, Defendants first provide
15 an overview of the relevant technology and then discuss the dispute(s) that the
16 parties’ proposed constructions present.⁵

17 **A. Transparent Router Patents (’892, ’727, ’995, and ’009 patents)**

18 The ’892, ’727, and ’995 patents⁶ all originate from a single patent
19 application and share largely the same specification. Although not directly in the
20 continuation chain of these patents, U.S. Patent No. 6,857,009 (“’009 Patent”)
21 incorporates the ’892 patent application by reference. ’009 Patent at 6:52-52. For

22 ⁴ The Nomadix patents repeatedly use this word “transparent” to describe the
23 process by which the nomadic router would help statically configured computers
24 connect to and communicate over the networks that they would encounter as they
25 moved around. As noted in this particular quote, the router would facilitate
connection “automatically and transparently” – *i.e.*, without requiring manual
reconfiguration and without the computer being “aware” that it is no longer at
home.

26 ⁵ For ease of reference, the disputed claim terms are highlighted within the
representative claims of each patent-in-suit in Ex. 33 [Exemplary Claims].

27 ⁶ The ’995 patent is a continuation of the ’727 patent, which is continuation-in-part
28 of the ’892 patent, which is a continuation-in-part of U.S. Pat. Appln. No.
08/816,174, filed on March 12, 1997, now abandoned. *See* ’995 Patent.

1 convenience, the '892, '727, '995, and '009 patents are collectively referred to in
2 this brief as the “Transparent Router Patents.”

3 The Transparent Router Patents all describe the “nomadic router” capable of
4 providing a statically configured computer with access to a foreign network,
5 without reconfiguring the computer’s network settings. *See, e.g.*, '892 Patent at
6 Abstract.

7 **1. “home” terms ('892, '727, '995, and '009 patents)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
home network '892: claim 1 '727: claim 20 '009: claims 1, 23	[network/gateway] to which the user device is configured to be connected and which corresponds to the home internet [or IP] address	network to which the user device is configured to be connected
home gateway '995: claims 1, 17, 24, 40		No construction is necessary

12
13 The disputes with respect to “home network” and “home gateway”
14 (collectively, “home terms”) are: (1) whether these terms should be construed as
15 explicitly defined in the patent specification or, as Nomadix argues, more broadly
16 to cover disclaimed subject matter and (2) whether the “home” in both terms should
17 be construed to mean the same thing.

18 Nomadix expressly defined the meaning of the “home” terms in its patents.
19 The patents, using definitional language, state:

20 It will be understood that the term “home” . . . is the network, gateway
21 or other communication devices or system to which the terminal is
22 normally connected and which corresponds to the home internet or IP
23 address.

24 '892 Patent at 6:15-19 (emphasis added); *see also* '727 and '995 Patents at 6:16-20.
25 Nomadix’s unambiguous definition of “home” in the specification is controlling
26 and should be adopted. *See Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d
27 1363, 1380 (Fed. Cir. 2009) (“When a patentee explicitly defines a claim term in
28 the patent specification, the patentee’s definition controls.”).

1 Nomadix argues that Defendants' construction reads limitations into the
2 claims. To the contrary, Nomadix expressly defined "home" in the specification
3 and must be held to that definition. Nomadix also argues that Defendants'
4 construction introduces ambiguity. But, Defendants took the proposed construction
5 straight from the specification. To the extent any ambiguity exists, it is a problem
6 of Nomadix's own making. Nomadix told the world what it meant by "home" and
7 now must live with its definition.

8 Nomadix seeks to ignore the clear language found in the specification so that
9 it may argue that the claims read on systems and methods that utilize DHCP. But,
10 Nomadix conceded during prosecution of these patents that user devices assigned
11 temporary IP addresses through DHCP (*i.e.*, those that have no concept of "home"
12 because their IP address changes frequently) do not fall within the scope of the
13 Transparent Router Patents' claims.⁷ During re-examination of the '892 patent,
14 Nomadix attempted to distinguish a prior art reference that assigned users a
15 temporary IP address through DHCP, arguing that "[t]he DHCP packet is **not**
16 intercepted" and "[t]he DHCP packet from the MH [mobile host] is **not** dropped" as
17 required by the claims. *See* Ex. 9 at 4 [05/16/07 '892 RE ROA]; *see also Microsoft*
18 *Corp. v. Multi-Tech Systems, Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) ("Any
19 statement of the patentee in the prosecution of a related application as to the scope
20 of the invention would be relevant to claim construction. . . ."); *Purdue Pharma*
21 *L.P. v. Endo Pharms. Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006) ("Under the
22 doctrine of prosecution disclaimer, a patentee may limit the meaning of a claim
23 term by making a clear and unmistakable disavowal of scope during prosecution.").
24 Thus, both the specification and the prosecution history support Defendants'
25 proposed construction.

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⁷ "[S]tatements from prosecution of a familial patent relating to the same subject
28 matter as the claim language at issue in the patent being construed... are relevant in
construing the claims at issue." *Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307,
1314 (Fed. Cir. 2007).

Finally, Nomadix challenges Defendants' construction by arguing that the term "network" and "gateway" should be defined differently. But, Defendants do not contend that "network" and "gateway" have the same meaning. Rather, Defendants contend only that the modifier "home" has the same meaning, regardless of whether it modifies "network" or "gateway."

2. "foreign" terms ('892, '727, '995, and '009 patents)

Because the terms "foreign network," "foreign gateway," and "first network" (collectively, "foreign terms") describe the same concept based upon the same disclosure, these terms should be afforded the same construction.

Claim Term	Defendants' Construction	Nomadix's Construction
foreign network '892: claims 1, 8 '009: claims 1, 23	[network/gateway] to which the user device is not normally connected and which corresponds to a local internet [or IP] address that is not the home internet [or IP] address	a network other than the home network
foreign gateway '995: independent claims 1, 17, 24, 40		a gateway not on a network of the home gateway
first network '727: claims 19, 20		No construction is necessary

The parties' disputes with respect to the "foreign terms" are essentially the same as the disputes for the "home" terms, namely: (1) whether the construction of these terms should include a requirement that the IP address be different from the home IP address and (2) whether "first network" requires construction.

a) "foreign" network/gateway

Just as the "home" network or gateway must correspond to the "home" Internet address, the "foreign" network or gateway must correspond to an IP address that is not the home IP address.⁸ The claims indicate that "foreign" network is distinguished from "home" network by the different IP addresses. Claim 1 of the '995 patent, for example, claims a method of communicating through a foreign gateway and requires that the "foreign gateway has an IP address

⁸ In fact, Nomadix' proposed construction is consistent with the Defendants' construction. See Op. Br. at 11.

1 different from the home gateway.” Similarly, claim 1 of the ’892 patent claims a
2 method for communicating over a “foreign” network and notes that packets that are
3 targeted to the “home” network are “intercepted.” As such, a proper definition of
4 the “foreign” network or gateway should include the IP address that logically
5 defines a device as a member of a particular network.

6 Indeed, that point is made even clearer by the ’892 patent re-examination file
7 history. During re-examination, Nomadix emphasized the importance of network
8 settings, such as IP addresses, in distinguishing a “home” network from a “foreign”
9 network. Nomadix stated, in pertinent part, “[t]he foreign network will have an IP
10 address that is unique to it. . . . The foreign network has a different IP address”
11 Ex. 10 at 3 [04/01/09 ’892 RE ROH].

12 Nomadix claims that Defendants’ constructions are vague and narrow. Op.
13 Br. at 17. To the contrary, Defendants’ construction adopts the express definition in
14 the patent specifications. *See, e.g.*, ’892 Patent at 6:15-19; ’995 Patent at 6:16-20.
15 On the other hand, Nomadix’s proposed constructions vaguely define the “foreign”
16 network or gateway as anything other than the “home” network or gateway. *See*
17 Op. Br. at 11 (“A device’s ‘home’ network is the network that it is configured for.
18 Any other network is a ‘foreign’ network.”); *id.* at 16 (“Accordingly, in the context
19 of the claims, ‘a foreign gateway’ is ‘a gateway not on a network of the home
20 gateway.’”). These statements do not explain to the jury the differences in the
21 disputed terms. From the viewpoint of a user device, the “foreign” terms are
22 different from the “home” network or gateway to which the user device normally
23 connects because their IP addresses are different from the IP addresses of the
24 “home” network or gateway. *See, e.g.*, ’892 Patent at 2:63-65, 6:15-19, 7:30-57,
25 8:11-17; ’995 Patent at 3:4-6, 6:16-20, 7:30-57, 8:12-25.

26 **b) “first network”**

27 The parties dispute whether “first network” is broad enough to encompass
28 any network, including the “home” network. Nomadix, by offering no construction

1 for this term, hopes to be able to read this term broadly enough to cover a “home”
2 network. Op. Br. 20 (“Simply put, ‘first network’ by itself refers to any network,
3 not necessarily a foreign network.”). As discussed below, this construction is
4 contradicted by the claim language and is an improper attempt to recapture claim
5 scope given up during prosecution of the ’727 patent. Defendants’ proposed
6 construction, which properly excludes the “home” network, is, on the other hand,
7 supported by the intrinsic evidence.

8 The claim language itself demonstrates that the “first network” cannot be the
9 “home” network. For example, the preamble of claim 20 states “[t]he method of
10 claim 19 wherein the user device is configured to communicate over a home
11 network having network settings incompatible with the first network . . .”
12 (emphasis added). Under Nomadix’s construction, which allows the “first
13 network” to be a “home” network, claim 20 would make no sense. Adopting
14 Nomadix’s construction would render the prerequisite for performing the method of
15 claim 20 impossible as a “home” network cannot have network settings that are
16 incompatible with the “home” network. On the other hand, Defendants’
17 construction makes clear that the “first network” cannot be the “home” network and
18 as such satisfies the preamble requirement of claim 20. Furthermore, if “first”
19 meant “home,” there would be no need for “intercepting user device messages ...”
20 or “modifying incorrectly configured messages transmitted by the user device ...”
21 as claim 19 of the ’727 patent requires. *See The Gentry Gallery Inc. v The Berkline*
22 *Corporation*, 134 F. 3d 1473, 1479-80 (Fed. Cir. 1998).

23 The claims would make no sense if the “first network” could be the “home”
24 network for yet another reason. As even Nomadix has conceded, the claims require
25 a user device with a “static IP address.” *See AJCCS* (Dkt. No. 248), Ex. 2 at 6
26 (“user device having a permanent address”). The specification also consistently
27 teaches that the user device has a *permanent address* from the network to which it
28 is normally connected, *i.e.*, the “home” network. *See ’727 Patent* at 2:5-26. Stated

1 another way, the “first network” cannot be the network that corresponds to the user
2 device’s permanent address. The patent claims a method for providing connectivity
3 to a “first network” and the specification explains that “a ‘Nomadic’ router or
4 translator enables a laptop computer ... configured to be connected to a local home
5 network to be connected to any location on the internet ... the processor intercepts
6 the message and translates the outgoing data by replacing the permanent address
7 with the router address as the source address.” *See id.* at 2:5-26 (emphasis added).
8 If the “first network” could be the “home” network there would be no need to
9 provide connectivity, as the computer would already be configured to communicate
10 with its “home” network.

11 Further, the specification makes clear that the dynamically configured
12 devices are not within the scope of this claim. *Id.* at 12:43-50 (“Nomadic router **10**
13 may also provide other network services to host computer **12**. For example, host
14 computer **12** may be able to utilize the DHCP service to obtain configuration
15 information rather than being manually configured. However, a host computer
16 utilizing the DHCP service requires that a DHCP server be installed on the network
17 segment to which it is currently attached. If the host computer **12** is configured to
18 use this service but a DHCP server is not available on the remote/foreign network,
19 nomadic router **10** will intercept the DHCP requests and respond with configuration
20 information for host computer **12** to use.”) (underline added).

21 The prosecution history also supports Defendants’ construction. For
22 example, in response to a prior art rejection, Nomadix narrowed the scope of claim
23 19 to overcome that rejection⁹ and stated that “[a]mended independent claim 19
24 provides a method for providing connectivity to a foreign network for a user
25 device.” Ex. 35 at 11 [06/07/04 ’727 ROA] (emphasis added). The amendment
26 clearly show that the claims of the ’727 patent are not directed at just “any

27 ⁹ See Ex. 11 at 2 [04/22/04 ’727 OA] (“Referring to claims 1 and 19, Bronstein
28 discloses a method for providing connectivity to a second local area network for a
user device configured for a first local area network . . .”).

1 network.”

2 Nomadix’s effort to make “first network” mean “any network” also ignores
3 claim amendments that it made as a result of litigation¹⁰ involving the ’892 patent
4 (parent of the ’727 patent). While prosecuting the ’727 patent and after the PTO
5 issued a notice of allowance, Nomadix informed the PTO that the term “foreign
6 network” had been identified in litigation as indefinite and lacking written support
7 in the ’892 patent specification.¹¹ The Examiner agreed with Nomadix’s
8 submission and rejected the ’727 patent claims as invalid under 35 U.S.C. § 112.¹²

9 To overcome the rejections, Nomadix amended the ’727 claims to use “first”
10 in place of “foreign.” Nomadix argued that the discussion of a “remote or foreign
11 network” in the specification provided written disclosure for “first network.”
12 Although the specification also discussed “home” network, Nomadix never
13 indicated that the discussion of “home” network provided support for the claimed
14 “first network.” Ex. 12 at 19 [03/09/06 ’727 ROA] (“Examiner posited that ... the
15 term[] “foreign network” ... lack[s] support in the written description. Amended
16 independent claim 19 recites ... a “first network” ... The specification describes ...
17 the configuration of a first network such as a remote or foreign network As
18 such, the written description supports the term ‘first network’.”). This amendment,
19 coupled with the Nomadix’s other amendments narrowing claim 19 to require a
20 user device with a permanent address, are further evidence that the “first network”
21 is not the user device’s network at its “home” or base location. *See* ’727 Patent at
22 6:8-10.

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¹⁰ See *IP3 Networks, Inc. v. Nomadix, Inc.*, No. 3:04-cv-1485-BTM-POR (S.D. Cal.) (filed July 23, 2004); *see also* Ex. 12 at 19 [03/09/06 ’727 ROA].

¹¹ See Ex. 13 at 1-3 [04/04/05 ’727 RCE and Amdt.].

¹² See Ex. 14 at 2-3 [10/05/05 ’727 OA].

1 **3. “user device having an incompatible IP address” (’727**
2 **patent)**

3 Claim Term	4 Defendants’ Construction	5 Nomadix’s Construction
6 user device having 7 an incompatible 8 private IP address ¹³ 9 ’727: claim 11	10 user device configured with 11 a permanent IP address from 12 the home network	13 user device configured 14 with a private IP address 15 not compatible with the 16 network
17 incompatible 18 private IP address	19 a unique IP addresses that 20 can never match the unique 21 private IP address of the user 22 device ¹⁴	23 private IP address not 24 compatible with the 25 network

26 The parties agree that a “user device having” means a “user device
27 configured with.” The parties, however, disagree as to whether an “incompatible
28 private IP address” is a “permanent IP address from the home network.”

1 At its core, this dispute is once again about whether the “incompatible”
2 address results from a static IP based computer system. Nomadix has put forth no
3 evidence that “incompatible private IP address” has any ordinary or customary
4 meaning. To the contrary, like “home” network and “foreign” network, the use of
5 the phrase “incompatible private IP address” is referring to the “permanent IP
6 address from the home network.” Defendants’ proposed construction makes clear
7 that a user device’s IP address from its “home” network is “incompatible” with a
8 “foreign” network because the “foreign” network must be using private IP
9 addresses that are different from the user device’s “home” network. On the other
10 hand, Nomadix’s definition amounts to no definition at all by merely defining
11 “incompatible” as “not compatible” and little else.

12

¹³ A private IP address is any IP address that falls within one of three IP address
13 ranges reserved for private network use.

14 ¹⁴ “[I]ncompatible private IP address” is common to two terms in the parties’ initial
15 JCCS (Dkt. Nos. 202 and 214) (“utilizing private IP addresses for a user device
16 having an *incompatible private IP address*” and “user device having an
17 *incompatible private IP address*”). In the preparation of the reduced set of claim
18 terms, the network perspective of an incompatible private IP address was
19 inadvertently left in the Defendants’ proposed construction for “incompatible
20 private IP address,” which was derived from an earlier proposal for “utilizing
21 private IP addresses for a user device having an incompatible private IP address.”

1 The specification does not use the phrase “incompatible private IP address.”
2 Other than in the claims, the term “private IP address” is not used anywhere else in
3 the specification. The file history however supports Defendants’ position.
4 Nomadix described “private” and “permanent” synonymously in the file history.
5 Specifically, in response to a written description rejection that cited the disputed
6 term “incompatible private IP address,” Nomadix repeatedly referred to “permanent
7 address,” “permanent internet address,” and “permanent IP address” as providing
8 support for the disputed term:

9 The Examiner posited that ... ‘incompatible private IP’ [address]
10 lack[s] support in the written description ... the IP address of the user
11 device has to be reconfigured each time the user device moves to a
12 new network (page 3, lines 27-29); the Nomadic Router provides ‘a
13 permanent IP address’ to the user device (page 4, lines 1-2); . . . the
14 user device has a ‘permanent internet address which conveniently
15 need not be changed in accordance with the present invention’ (page
16 9, lines 16-17); the **user device has a ‘home internet or IP address**
17 (page 9, lines 25-26); the Nomadic Router ‘provides the mapping
18 between the location based IP address used in the internet today and
19 the permanent user based address housed in the CPU in the [user]
20 device 12’ (page 12, lines 10-14; and FIG. 2 - the ‘IP Mapping’
21 element); the Nomadic Router has a protocol for specifying the
22 ‘mapping between permanent and temporary IP addresses’ (page 12,
23 lines 15-21); ... As such, the written disclosure supports the term[] . . .
24 ‘incompatible private IP address’. [sic]

25 Ex. 12 at 14-16 [03/09/06 ’727 ROA] (emphasis added). As such, Defendants
26 proposed a construction that is consistent with the patentees’ statements and the
27 support identified during prosecution of the ’727 patent.

28 By contrast, Nomadix does not even attempt to construe the disputed terms.

1 Nomadix simply proposes to construe “incompatible” as “not compatible,” which
2 would not help a jury understand what it means for a private IP address to be
3 incompatible with a network. *O2 Micro International Ltd. v. Beyond Innovation*
4 *Technology Co., Ltd.*, 521 F. 3d 1351, 1362 (Fed. Cir. 2008); *see also U.S. Surgical*
5 *v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (the purpose of claim
6 construction is to resolve disputed meanings of claim terms, not to repeat or restate
7 claims terms).

8 Nomadix’s claim construction arguments ignore the fact that the specification only provides support for a user device configured with a unique or permanent IP address from its “home” network. Op. Br. at 24-25. Specifically, the specification states that “[t]he nomadic router automatically converts the actual location address to a unique communication address for the user such as an internet address, such that the terminal [i.e., the user device] performs communications originating from the communication address regardless of the physical location of the terminal.” ’727 Patent at 2:44-49 (emphasis added). Further, the specification states “the present nomadic router provides a separation of location and identity by providing a permanent IP address to the network device (host).” *Id.* at 3:1-3 (emphasis added); *id.* at 6:7-9 (“Host device 12 may be provided with a permanent internet address which conveniently need not be changed in accordance with the present invention.”) (emphasis added).

21 **4. “incorrectly configured messages” (’727 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
incorrectly configured messages ’727: claim 19	messages addressed to an incorrect address	No construction is necessary

22 Despite the fact that the ’727 patent specification never uses the phrase
23 “incorrectly configured messages” anywhere but in the claims, Nomadix argues that
24 a jury will understand this term and that it need not be construed. Nomadix is
25 wrong. A jury cannot be asked to understand this technically complex phrase when
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1 it is nowhere in the patent, and Nomadix has introduced no evidence that this term
2 has an ordinary and customary meaning to a person of ordinary skill in the art, let
3 alone to the average juror.

4 While the written description is replete with references to how user devices
5 are “configured” it does not explain how a message – *i.e.*, a packet of information
6 sent out by a computer – can be “configured,” much less “incorrectly configured.”
7 Indeed, the PTO issued a rejection under 35 U.S.C. § 112 on the grounds that this
8 term lacked support in the specification. In response, Nomadix explained that “a
9 user device is configured to be connected to a local home network such that the user
10 device transmits messages based on its configuration.” Ex. 12 at 21 [03/09/06 ’727
11 ROA]. As Nomadix further explained, “the user device may not be able to
12 communicate with a new network to which the user device is connected when the
13 user device is ‘configured incorrectly’ for the network.” *Id.* In other words,
14 Nomadix informed the PTO that there was support in the written description for
15 “incorrectly configured messages” because the written description described
16 incorrectly configured devices.

17 The ’727 specification explains that a host or user device is incorrectly
18 configured when it attempts to send packets to an address that cannot receive them:
19 “a router will receive the packets only if the host computers specifically send
20 (address) the packets to that router ... If a host is configured incorrectly (bad
21 address or address of a router not on the local network), then the host computer and
22 router will be unable to communicate, *i.e.*, the router will not listen to the host or
23 will ‘drop’ packets.” ’727 Patent at 1:48-54 (emphasis added). The only logical
24 conclusion one can reach then is that “incorrectly configured messages” are those
25 sent to an incorrect address, *i.e.*, to a gateway that is not on the network.

26 Nomadix apparently concedes that an incorrect address constitutes “one kind
27 of incorrectly configured message.” Op. Br. at 26. But Nomadix provides no
28 evidence that the term should be construed more broadly. Instead, Nomadix argues

1 that claim 19 of the '727 patent demonstrates that, in some instances, a message
2 will be “incorrectly configured” because the address of the user’s device is
3 “incorrect.” *Id.* at 27. This argument is simply wrong. A user device’s address is
4 what it is and cannot be “incorrect.” Similarly, the fact that claim 19 describes
5 messages that are modified by replacing the source address with the router address
6 does not mean that the source address is what makes the message “incorrectly
7 configured.” To the contrary, the claim *separately* requires that the message have
8 “the permanent address of the user device as a source address.” That permanent
9 address cannot remain the source address of the message after the router fixes the
10 bad destination MAC address because the resulting, “corrected” message comes
11 from a new source – the router itself. The “wherein” clause imposes precisely that
12 additional limitation: the source address must be changed from the static IP address
13 of the user device to the router’s address (to ensure that any responsive message
14 returns to the router, for delivery to the device).

15 The source address translation just described must occur any time user device
16 messages are “intercepted” and modified – without regard to the reason for the
17 modification. Thus, the presence of the words “incorrectly configured” has to
18 import some other meaning to the claim. *Agilent Technologies, Inc. v. Affymetrix,*
19 *Inc.*, 567 F.3d 1366, 1378 (Fed. Cir. 2009) (“A claim construction that gives
20 meaning to all the terms of the claim is preferred over one that does not do so.”)
21 (citation omitted).

22 Finally, Nomadix argues that Defendants’ construction of this phrase
23 “applies only in absurd circumstances.” Op. Br. at 26. To the contrary,
24 Defendants’ construction applies directly to the problem purportedly solved by
25 these patents: what happens when a device moves from one network to another but
26 continues to direct messages to the MAC address of the gateway on the “home”
27 network. Nomadix’s solution was to have its nomadic router “correct” those
28 messages.

1 Nomadix's alternate scenario, that a user types in "www.google.com" but the
2 resulting packet is addressed to "www.yahoo.com," is absurd and not at all what
3 Defendants have argued or will argue. The whole point of how the modern Internet
4 works is that two destination addresses are required: an IP address for the ultimate
5 destination and a MAC address for the next device on the journey to that
6 destination. From the perspective of any local network, the destination IP address
7 will typically be for some distant device (*e.g.*, a webserver for Google or Yahoo).
8 As far as the local network is concerned, almost any IP address is "correct," but that
9 is not true of the destination MAC address. That address can certainly and easily be
10 "incorrect." As just explained, if that MAC address is not associated with any
11 device on the LAN, the message addressed with it will be dropped. Thus, if a
12 computer has a permanent IP address (as is the case for these claims) and moves to
13 a different network, any message that it would send (including a request for
14 www.google.com) will contain the destination MAC address of the wrong gateway.
15 Because that gateway is not on the current network, that address is "incorrect" and
16 the message containing it would be dropped. Defendants' construction is designed
17 to capture this circumstance – and the specification describes no other.¹⁵

18 **5. "user host device is configured to communicate . . . by using
19 an IP address of the home gateway" ('995 patent)**

Claim Term	Defendants' Construction	Nomadix's Construction
the user host device is configured to communicate through a home gateway by using an IP address of the home gateway <small>'995: claims 1, 17, 24, 40</small>	the user device is configured with a permanent IP address to communicate through a home gateway	No construction is necessary

25 Despite the fact that Nomadix has stipulated that user devices "configured to

26 ¹⁵ Nomadix' exercise in absurdity underscores the need for a precise construction of
27 this term. The obfuscating example that Nomadix raises would be further removed
28 by simply changing the Defendants' proposal to read, "messages addressed to an
incorrect MAC address." Defendants have no objection to this further
modification, if the Court is so inclined.

1 communicate with a home network” in the ’892 patent require a static or permanent
2 IP address for the user device (*see* AJCCS, Dkt. No. 248, Ex. 1), Nomadix argues
3 that the ’995 patent should not be similarly limited – even though the ’995 patent is
4 a continuation of the ’892 patent, shares much of the same specification, and
5 contains essentially the same claim limitation. The plain language of the claims
6 should be construed consistently across all patents in the family. *NTP, Inc. v.*
7 *Research In Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005). In both the ’995
8 patent and the ’892 patent, the claims and specification make clear that a permanent
9 IP address is what “configure[s]” the user host device “to communicate through a
10 home” network and the gateway on that network.¹⁶ Nomadix’s attempt to avoid
11 construction does not resolve the scope of the ’995 patent for the jury and
12 contradicts its own agreed construction of the ’892 patent.

13 The ’995 patent claims are directed at receiving and processing Address
14 Resolution Protocol (ARP) packets that are targeted for a user device’s home
15 gateway. For background, an ARP request packet is a request that asks other
16 devices on a particular network to tell the sender what the MAC address is for a
17 given IP address. As reflected by the prior art that Nomadix cited to the Examiner,
18 ARP, including proxy ARP¹⁷, is an old and well-known way for a device to obtain
19 the MAC address of, *e.g.*, a default gateway on a network. *See* ’995 Patent at 3
20 (citing Network Working Group Requests for Comments: 1919–Classical Versus
21 Transparent IP Proxies (Mar. 1996)). Proxy ARP is not used in connection with
22 computers using DHCP, as the DHCP process automatically informs the computer
23 of the default gateway’s address.

24 ¹⁶ The parties separately dispute the meaning of “home” gateway. Because
25 Defendants believe “home” gateway should be construed consistently with “home”
network, both terms are addressed in Section III.A.1.

26 ¹⁷ A gateway device can be configured to provide its own MAC address in response
27 to an ARP request even though that request seeks the MAC address of an IP
28 address other than the gateway’s. When a gateway device does this, it is engaging
in what is called “proxy ARP.” *See* ’995 Patent at 3 (citing Network Working
Group Requests for Comments: 1027–Using ARP to Implement Transparent
Subnet Gateways (Oct. 1987)).

1 Defendants' construction is supported by the claim language, which requires
2 that "the user host device is configured to communicate through a home gateway by
3 using an IP address of the home gateway." Only a user host device with a
4 permanent IP address would be trying to communicate over a foreign network using
5 an IP address of a "home" gateway. If a user host device were assigned a
6 temporary IP address, as Nomadix implies, there would be no need to transmit an
7 ARP request packet containing the IP address of its "home" gateway, as the claims
8 expressly require.

9 The specification further supports Defendants' construction that a permanent
10 IP address is required. The "Summary of the Invention" section states that the
11 nomadic router "enables a laptop computer or other terminal which is configured to
12 be connected to a local home network to be connected to any location on the
13 internet . . ." *Id.* at 2:11-13. After the user device transmits a message, "the
14 processor intercepts the message and translates the outgoing data by replacing the
15 permanent address with the router address as the source address." *Id.* at 2:25-27
16 (emphasis added). Further, the router "translates the incoming data by replacing the
17 translator address with the permanent address as the destination address." *Id.* at
18 2:29-31 (emphasis added). The patents make repeated references to permanent
19 addresses in the Summary of the Invention, indicating that the claims are limited to
20 user devices with a permanent IP address. *C.R. Bard, Inc. v. U.S. Surgical Corp.*,
21 388 F.3d 858, 864 (Fed. Cir. 2004) ("Statements that describe the invention as a
22 whole, rather than statements that describe only preferred embodiments, are more
23 likely to support a limiting definition of a claim term.").

24 To counter Defendants' construction, Nomadix raises two inapposite points.
25 First, Nomadix contends that Defendants "change the meaning of the claim
26 language by omitting that the IP address is the IP address 'of the home gateway.'" Op. Br. at 15. A permanent IP address to communicate through a "home" gateway
27 necessarily requires the use of an IP address of the "home" gateway. As identified
28

1 in the problem the Nomadix patents sought to solve, if the permanent IP address
2 were not for the “home” gateway, the user device could not communicate through
3 the “home” gateway. ’995 Patent at 3:43-50, 6:7-11. Further, if the user device
4 were not configured to communicate using the permanent IP address of its “home”
5 gateway, the nomadic router would need to assign a temporary IP address. ’995
6 Patent at 12:61-67.

7 Second, Nomadix argues that “the claim language is clear on its face”
8 because the user host device is configured to communicate with the “home”
9 gateway. Op. Br. at 14. Nevertheless, the claim language is *not* clear on its face
10 what type of configuration meets this limitation. To the extent that Nomadix argues
11 that any IP configuration – static IP or temporary assignment through DHCP – falls
12 within the scope of the claim, Nomadix would broaden the scope to encompass any
13 use of an IP address. Had Nomadix intended the claim to cover all communications
14 using an IP address, it could simply have drafted the claim to read “user host
15 device.” Instead, Nomadix included additional limitations about how the user host
16 device is configured, which must affect the meaning of the term. *Agilent*
17 *Technologies*, 567 F.3d at 1378 (“A claim construction that gives meaning to all the
18 terms of the claim is preferred over one that does not do so.”) (citation omitted).

19 **6. “single connection . . .” (’009 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
single connection between the device and the computer ’009: claims 1, 23	connection between the device and the computer that does not copy data between two sessions or use application buffering	No construction is necessary

23 The parties dispute whether this term requires construction at all.
24 Construction is necessary because of the “intentional disclaimer, or disavowal of
25 claim scope by the inventor.” *Phillips v. AWH Corporation*, 415 F.3d 1303, 1316
26 (Fed. Cir. 2005).

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1 Nomadix disclaimed copying data between two sessions and the use of
2 application buffering in the '009 patent specification. Specifically, Nomadix stated:

3 Whether or not the client is configured to use a proxy service, a
4 connection is established between the client and the configuration
5 manager, and between the configuration manager and the origin server.

6 Rather than copying data between these two sessions, the present
7 invention transfers the session flow control functions to the endpoints
8 to effectively splice the connections together while maintaining the
9 end-to-end semantics. To splice the connections, the configuration
10 manager modifies the message header and retransmits the message so
11 there is no need for application buffering.

12 '009 Patent at 3:37-47 (emphasis added). This passage disclaims the copying of
13 data and application buffering for “the present invention,” not just an embodiment.
14 “When a patent … describes the features of the ‘present invention’ as a whole, this
15 description limits the scope of the invention.” *Verizon Services Corp. v. Vonage*
16 *Holdings Corp.*, 503 F.3d 1295, 1305 (Fed. Cir. 2007). See also *SciMed Life Sys.,*
17 *Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001)
18 (“[T]he characterization of the coaxial configuration as part of the ‘present
19 invention’ is strong evidence that the claims should not be read to encompass the
20 opposite structure.”) (emphasis added); *C.R. Bard*, 388 F.3d at 864 (“Statements
21 that describe the invention as a whole are more likely to be found in certain sections
22 of the specification, such as the Summary of the Invention.”).

23 That a “single connection” excludes copying and buffering is further
24 confirmed by other intrinsic evidence¹⁸, including the cited IBM Research Paper.
25 Ex. 27. In that paper, the authors repeatedly state that the single connection created
26 by their new splicing technique does not copy data and does not use buffering. See

27
28 ¹⁸ “(P)rior art cited in a patent … constitutes intrinsic evidence.” *V-Formation,*
Inc. v. Benetton Group SPA, 401 F.3d 1307, 1311 (Fed. Cir. 2005).

1 *id.* at 2 (“the proxy does not have to buffer any packets”); *id.* at 2-3 (“the data
2 copying part of the proxy—where the performance is normally lost—is replaced by
3 a single ioctl() call to set up the splice.”); *id.* at 12 (“By moving received data from
4 the input buffer directly to the output buffer, the systems save the overhead of
5 copying the data through application space. In TCP Splice, there *is no* input or
6 output buffer.”) (emphasis in original).

7 In sum, there is a legitimate dispute over the proper scope of the “single
8 connection” phrase, and that phrase therefore requires construction. Defendants’
9 construction is required by the patentees’ disclaimer from the “present invention” of
10 copying and buffering. Defendants’ construction should be adopted.

11 **B. The Transparent Redirection Patents ('894, '554, and '716
12 patents)**

13 The U.S. Patent No. 6,636,894 (“'894 Patent”), 7,194,554 (“'554 Patent”),
14 and 7,689,716 (“'716 Patents”)¹⁹ (collectively, the “Transparent Redirection
15 Patents”) all originate from a single patent application and have similar
16 specifications. They incorporate the same set of provisional applications. They
17 also incorporate the parent application to the Transparent Router Patents. Building
18 on the claimed nomadic router for statically configured computers, the Transparent
19 Redirection Patents added additional functionality to the nomadic router described
20 in the Transparent Router Patents. The Transparent Redirection Patents purport to
21 redirect transparently a user’s requests to a login page, control the user’s level of
22 access via a login profile, and present location-specific information on the login
23 page.

24 Like the Transparent Router Patents, the Transparent Redirection Patents
25 disclose a gateway that transparently intercepts a computer’s request for Internet
26 access to make a determination whether to allow the computer to access a “foreign”
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¹⁹ The '716 patent is a continuation of the '554 patent, which is continuation-in-part
of the '894 patent. *See* '716 Patent.

1 network without requiring a change in the user’s “home” network setting. *See, e.g.*,
2 ’894 Patent at 3:27-34; *see also* ’554 Patent at Abstract; *see also* ’716 Patent at
3 8:57-67. The ’894 patent describes directing a computer’s access request to a
4 redirection server if redirection is required. *Id.* The ’554 patent also describes
5 processing the users’ login information to determine access rights on the “foreign”
6 network. The ’716 patent describes presenting location-specific information to the
7 user on the login page generated by the redirection server.

8 **1. “the order of steps of all claims” (’894 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
the order of steps of all claims	The steps of all the claims must be performed in the order listed	No construction is necessary

9 The language of claims 1 requires that the method steps be performed in the
10 order recited. The nearly identical language in claim 6 requires that the claimed
11 system perform the recited operations in that same order.

12 **a. Claim 1**

13 A method claim requires a specific order of steps when, “as a matter of logic
14 or grammar, they must be performed in the order written.” *Altiris, Inc. v. Symantec*
15 *Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003). In particular, if a later step depends
16 on the result of a previous step, the steps must be performed in that order. *See, e.g.*,
17 *Elan Microelecs. v. Apple, Inc.*, No. C 09-01531 RS, 2010 WL 4510909, at *5
18 (N.D. Cal. Nov. 1, 2010) (“It is well established that where a claim step refers to the
19 completed results of a prior step, the order is a claim limitation.”) (*citing E-Pass*
20 *Techs., Inc. v. 3Com Corp.*, 473 F.3d 1213, 1222 (Fed. Cir. 2007)). Here, both logic
21 and grammar support Defendants’ construction.

22 As “a matter of logic,” each of the seven steps of claim 1 must be performed
23 in the recited order. Claim 1 requires: (1) “receiving” the request at the gateway
24 device; (2) “determining” whether the request requires redirection; (3) “storing” the
25 destination address if redirection is required; (4) “modifying” and “communicating”
26

1 the request to a redirection server if redirection is required; (5) “responding” to the
2 modified request; (6) “intercepting” and “modifying” the response; and (7)
3 “sending” the modified response to the computer. ’894 Patent, Claim 1. Each step
4 expressly depends on the ones before it. By way of illustration, the redirection
5 server responds to the “modified browser request” at step 5. But, the “modified
6 browser request” does not even exist until the gateway device modifies the original
7 request, at step 4. Therefore, step 5 must occur after step 4. Similarly, the gateway
8 device cannot “intercept” the browser redirect message, at step 6, until after the
9 redirection server sends the message, at step 5. The gateway device cannot send the
10 “modified” message to the computer, at step 7, until after it “modifies” the
11 message, at step 6. Each of the other steps is similarly constrained to occur in a
12 specific sequence.

13 The grammar of the claim also imposes an order to the steps. The “storing”
14 and “modifying and communicating” steps are performed only “if redirection is
15 required.” Until the gateway “determines” whether redirection is required, it does
16 not know whether the “storing” and “modifying and communicating” steps are to
17 be performed. Therefore, the “storing” and “modifying and communicating” steps
18 must be performed after the “determining” step.

19 Nomadix argues that there cannot be a required order when the claim
20 includes conditional elements. Op. Br. at 29 n.4. The Federal Circuit disagrees.
21 The use of “conditional language” “mandate[s]” an order of steps. *Altiris*, 318 F.3d
22 at 1367 (steps that are performed “if said testing automatically step indicates an
23 automation boot sequence” must be performed after the “testing automatically”
24 step); *see also Ring Plus, Inc. v. Cingular Wireless, LLC*, No. 2:06-CV-159-DF,
25 2007 WL 5688765, at *22 (E.D. Tex. July 9, 2007) (the step of “terminating the
26 telephone call . . . if the telephone line is busy” must be performed after the step of
27 “determining whether the telephone line . . . is busy”). Here, the use of the phrase
28 “if redirection is required” clearly and unambiguously imposes an order of steps.

b. Claim 6

Claim 6 recites a system, rather than a method, but it, too, requires a specific order of operations. When the plain language of a claim – even a system claim – describes a sequential process, a specific order is imposed. *See, e.g., Oak Tech., Inc. v. Int'l Trade Comm'n*, 248 F.3d 1316, 1325 (Fed. Cir. 2001); *see also Bio Tech. Gen. Corp. v. Duramed Pharm., Inc.*, 325 F.3d 1356, 1362 (Fed. Cir. 2003). Here, claim 6 recites a system for redirecting access requests that performs all the same steps as method claim 1. For example, claim 6 includes a “gateway device” that receives, determines, stores, and modifies in the same order as, and with nearly the identical language of, claim 1. In particular, claim 6, like claim 1, requires that the gateway device “store” and “modify” the original request only “if redirection is required.” ’894 Patent, Claims 1 and 6.

13 To the extent that there is any difference between the steps of claim 1 and
14 those of claim 6, claim 6 is even more explicit about the order of steps. Claim 1
15 requires “intercepting” and “modifying” the browser redirect message and then
16 “sending” the modified message to the user’s computer. Claim 6 replaces the
17 “sending” step with a “forwarding” step. But, it expressly states that the gateway
18 device intercepts and modifies “before forwarding the browser redirect message.”
19 (emphasis added).

c. Nomadix ignores the plain language of the claims and the prosecution history.

Nomadix offers two arguments to try to justify broadening the scope of its claims. Neither is adequate to the task. First, Nomadix mischaracterizes Defendants' construction. Defendants have never claimed the gateway must receive all requests before it can determine whether any of them require redirection. Claim 1 recites a list of steps that must be applied to each request that is to be redirected. The preamble to claim 1 describes the invention as method for redirecting "an" (singular) original request. Clearly, the gateway device cannot

1 determine whether a particular request requires redirection until the request has
2 been received. The fact that this method will be repeated over and over again for
3 all of the incoming requests does not change how the method applies to each
4 individual request.

5 Second, Nomadix contends that the “storing” step need not be performed
6 before the “modifying and communicating” step. But Nomadix ignores the
7 prosecution history, in which it clarified how the “modifying” step changes the
8 access request. The original request is modified by overwriting the original
9 destination address with the address of the redirection server. Ex. 15 at 5 [05/06/03
10 ’894 ROA] (“If redirection of the destination address access request is required,
11 then . . . the original destination address access request is modified with the
12 destination address of a redirection server.”). Once the modifying step has been
13 performed, the original destination address is gone and, therefore, cannot be stored.
14 Nomadix does not point to any support for the nonsensical position that the original
15 destination address can be stored after it has been overwritten with the new
16 destination address.

17 Both claim 1 and claim 6 require a specific order of steps. Defendants ask
18 the Court to instruct the jury that the steps of the ’894 patent claims must occur in
19 the order recited.

20 **2. “administrator” (’894 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
administrator '894: claims 1, 5, 6	a person who administers the gateway device	No construction is necessary

23 The parties dispute whether the term “administrator” requires construction.
24 Construction is required because the claim provides little guidance as to what an
25 “administrator” is. The term is used in independent claim 1 as follows:

26 responding, at the redirection server, to the modified request with a
27 browser redirect message that reassigns the modified request to an
28 administrator-specified, redirected destination address

1 '894 Patent, Claim 1 (emphasis added).

2 The specification explains that the administrator specifying the redirection
3 address is a person in charge of administering the gateway device. *Id.* at 8:25-28.
4 For example, the specification explains that “the computer network can provide
5 access to users and direct the users to portal pages established by the user, network
6 administrator or another entity.” *Id.* at 3:9-33 (emphasis added). The specification
7 also explains that “the gateway administrator can readily alter the parameters or
8 other settings in order to tailor the service according to their particular application.”
9 *Id.* at 9:61-64 (emphasis added). And, the specification explains that “the gateway
10 administrator will have the capability to dynamically change the information
11 supplied in the portal page based on many factors.” *Id.* at 10:31-36 (emphasis
12 added). These teachings make clear that the “administrator” is a person who
13 administers the gateway device.

14 Defendants’ proposed construction is consistent with Nomadix’s previous
15 claim construction briefing. Nomadix previously stated:

16 The ’894 patent discloses technology that allows network operators
17 like hotels to force computers connected to the network to behave in a
18 certain way . . . a hotel could ensure that any user connected to the
19 network views the hotel’s login page rather . . . than the user’s home
20 page . . . when the user first opens his browser.

21 Ex. 28 at 35 [Nomadix’s Op. Br.] (emphasis added). The “administrator-specified”
22 limitation of the “administrator-specified redirection destination address” requires a
23 person – for example, a hotel network operator – administering the gateway device.

24 **3. “access rights” terms (’554 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
[determines the access rights of the source / determining the access rights of the source based upon the	once the source is authenticated to access the network, determine[s/ing] the rights of the source to	No construction is necessary

1	identification of the source], wherein [the] access rights define the rights of the source to access destination sites via the network '554: claims 10, 17	access particular destination sites via the network based upon the identity of the source and the content and/or destination requested	
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6 The plain language of the '554 patent claims demonstrates that determining a
7 user's "access rights" goes beyond the simple gatekeeper functionality of allowing
8 or denying a user any access to the network. *Phillips*, 415 F.3d at 1314 ("the
9 claims themselves provide substantial guidance as to the meaning of particular
10 claim terms."). Indeed, claim 10 recites a system in which a server first determines
11 if a user "is entitled to access the network based upon the access information" and
12 only then "determines the access rights" of the user. Furthermore, claim 10 makes
13 clear that the purpose of the system is "for selectively controlling and customizing
14 access, to a network, by a source" (emphasis added).²⁰ '554 Patent, claim 10.
15 Without clear guidance from Defendants' construction, a jury may think that a
16 system providing exactly the same network access to all sources falls within the
17 claims – despite the fact that the claim requires the ability to customize a source's
18 access through "access rights."

19 Unlike the "all or nothing approach" of conventional methods, the
20 specification discloses a "system that allows users dynamic and customizable
21 access to a network such that the user's access and authorization to particular
22 networks or sites is customizable." '554 Patent at 2:57-61. The specification
23 accomplishes this goal through a two-step process. First, the AAA (Authentication,
24 Authorization, and Accounting) server authenticates the user based upon
25 information identifying the user, such as an ID or location. *Id.* at 3:12-18. Then,
26 "[o]nce authenticated," the server determines the user's access rights, "such that

27
28 ²⁰ According to the specification, "source" can refer to "a particular user, computer
or location" attempting to access the network. '554 Patent at 3:17-18.

1 sources have different access rights based upon their identity, and the content
2 and/or destination requested.”²¹ *Id.* at 3:18-22. “For example, it would be
3 advantageous for some users to be authorized access to all Internet sites, while
4 others may be denied access to particular sites.” *Id.* at 2:65-3:1. “[E]ach time the
5 user attempts to access a different destination, the user is subject to the AAA, so
6 that the user may be prevented access from a particular site the AAA system and
7 method deem inaccessible to the user based upon the user’s authorization while
8 permitting access to other sites that the AAA method and system deem acceptable.”
9 *Id.* at 3:35-41.

10 By declining to construe “access rights,” Nomadix tries to conflate the two-
11 step process in the claims of authenticating users and then “selectively permit[ting]
12 users a range of authorization” (from full access to access restricted to certain sites)
13 into the very “all or nothing approach” that Nomadix insisted its system was “not
14 based upon.” *Id.* at 3:3-5. Nomadix cannot escape the clear import from the claims
15 and specification that “access rights” do not simply allow a source onto the
16 network, but define which sites the source may visit once on the network.

17 Nomadix argues that Defendants’ construction imposes an order of steps to
18 the ’554 patent claims without justification. Op. Br. at 33. But common sense and
19 the plain language of the claims indicates that the step of “determin[ing] if the
20 source is entitled to access the network” must precede the step of “determin[ing] the
21 access rights,” i.e., “the rights of the source to access destination sites.” *Ring Plus,*
22 *Inc. v. Cingular Wireless Corp.*, 614 F.3d 1354, 1364 (Fed. Cir. 2010) (“Because a
23

24 ²¹ Although claim 17 requires that “access rights” are “based upon the identification
25 of the source” and claim 10 does not, the specification’s clear disclosure that
“access rights” are based upon the “identity” of the source “and the content and/or
26 destination requested” overrides the presumption of claim differentiation. *Curtiss-*
Wright Flow Control Corp. v. Velan, Inc., 438 F.3d 1374, 1381 (Fed. Cir. 2006).
Moreover, there are numerous other differences between system claim 10 and
method claim 17. *Kraft Foods, Inc. v. Int’l Trading Co.*, 203 F.3d 1362, 1368 (Fed.
Cir. 2000) (claim differentiation “does not mean that every limitation must be
27 distinguished from its counterpart in another claim, but only that at least one
28 limitation must differ”).

1 sound presentation cannot be ‘allowed to continue’ before the presentation is first
2 played, the required order of the steps necessarily indicates that ‘allowing’ a sound
3 presentation means allowing the presentation to begin.”) (emphasis in original).

4 **4. “regardless of network configurations” ('554 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
regardless of network configurations ’554: claims 10, 17	regardless of the hardware, MAC addresses, IP addresses, and networking protocols used by the network and the source computer	No construction is necessary. However, if the Court is inclined to construe the term, Nomadix proposes: regardless of network address settings.

9 The parties dispute the meaning of “regardless of network configurations.”
10 The patent claims and specification provide little guidance as to the meaning of the
11 phrase. It is the prosecution history for the ’554 patent that clarifies what the
12 phrase means, and Defendants’ construction reflects that clarification.

13 **a. Regardless of networking protocols**

14 Throughout prosecution of the ’554 patent, Nomadix argued that an essential
15 feature of its invention was a “universal gateway device” capable of connecting any
16 computer to any network, regardless of networking protocols.²² It was this feature
17 – and this feature alone – that distinguished Nomadix’s invention from the prior art.
18 Nomadix cannot now broaden the scope of its patent to recover what it has
19 expressly disclaimed. *See, e.g., Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d
20 1570, 1576 (Fed. Cir. 1995) (“Claims may not be construed one way in order to
21 obtain their allowance and in a different way against accused infringers.”).

22 The PTO repeatedly rejected every claim of the ’554 patent as being
23 anticipated by, or obvious in light of, U.S. Patent No. 6,385,653 (“Sitaraman”). *See*
24 Ex. 18 [04/15/05 ’554 OA]; Ex. 19 [12/21/05 ’554 OA]; Ex. 20 at 5 [05/26/06 ’554
25 OA]. Nomadix added the phrase “regardless of network configurations” after one

26
27 ²² The applicant had tried, and the Examiner had rejected, two earlier formulations
28 to capture this core concept: “transparent access” and “pre-defined relationships”/“pre-assigned protocols.” *See* Ex. 16 at 8-12 [12/13/04 ’554 ROA];
Ex. 17 at 7-10 [02/11/05 ’554 ROA]; Ex. 18 at 5 [04/15/05 ’554 OA].

such rejection. *See* Ex. 21 [10/17/05 '554 ROA]. Sitaraman included a “protocol layer” that could communicate with a source computer via multiple different protocols, using a variety of “protocol handlers.” *Id.* at 8; *see also* Ex. 37 at 4:39-49 [Sitaraman '653 Patent]. Nomadix admitted that the Sitaraman gateway was “robust.” Ex. 21 at 8 [10/17/05 '554 ROA]. But it was not robust enough. According to Nomadix, Sitaraman did not operate “regardless of network configurations” because the source computer was limited to using one of only a finite number of protocols that the gateway supported:

[T]he protocol layer (110) [of Sitaraman] does not enable a computer to communicate with the network regardless of network configurations. To the contrary, the protocol layer only supports clients who utilize one of the specific application protocols for which a protocol handler has been installed, *and not other protocols*. . . . If the protocol is not supported, however, the computer user will be unable to communicate with the network.

Id. at 8 (italics added). By adding “regardless of network configurations,” Nomadix clearly limited its claims to “gateway devices” that support all “other protocols.”

The PTO once again rejected Nomadix’s claims, noting that the Sitaraman gateway was “scalable to support additional network access methods” by adding protocol handlers to accommodate any new networking protocols encountered, thereby teaching “access to any network regardless of network configurations.” Ex. 19 at 11 [12/21/05 '554 OA] (emphasis in original). Nomadix amended its claims again, this time clarifying how its universal gateway device would support all “other protocols”: it would do so “via a packet translation learned during a self configuration.” Ex. 22 at 8-9 [03/21/06 '554 ROA].

The PTO eventually allowed the claims. In its Notice of Allowability, the patent examiner specifically cited the ability to “access any network regardless of network configurations via packet translation learned during self configuration” as

1 the basis for its allowance. Ex. 23 at 2 [11/28/06 '554 Notice of Allowability].
2 Where a patent applicant so clearly limits the scope of a claim by amendment,
3 construction to capture the prosecution history disclaimer is appropriate. *Gillespie*
4 *v. Dywidag Sys. Int'l*, 501 F.3d 1285, 1291 (Fed. Cir. 2007) ("The patentee is held
5 to what he declares during the prosecution of his patent."). Defendants propose that
6 "regardless of network configurations" be construed to include "regardless of . . .
7 networking protocols" precisely to convey this disclaimer.

8 **b. Regardless of IP addresses**

9 The phrase "regardless of network configurations" also requires that the
10 gateway device connect any computer to any network regardless of IP addresses.
11 Nomadix has conceded that the gateway device must operate "regardless of
12 network address settings." Op. Br. at 35-37. IP addresses are "network address
13 settings." IP addresses are assigned by the network to identify the source and
14 destination of network traffic. At the time the '554 patent was filed, a computer
15 had to be configured with its own IP address and that of the gateway device.
16 Provided it is understood that "network address settings" includes these IP
17 addresses, Defendants do not object to the use of the more generic term.

18 Even if Nomadix disputes Defendants' understanding of what constitutes a
19 "network address setting," the patent supports Defendants' construction that the
20 gateway device operates regardless of IP addresses. The '892 patent states²³ that
21 the universal gateway device allows a computer to connect to the network without
22 changing its IP address. The universal gateway "removes any burden on the user
23 for device reconfiguration (e.g., IP address configuration, gateway or next hop
24 router address, netmask, link level parameters, and security permission)." '892
25 Patent at 8:14-17 (emphasis added). The '892 patent further explains that the
26 gateway device is able to reconfigure itself to use whatever IP addresses are

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²³ The '554 patent incorporates the '892 patent by reference. Ex. 22 at 8 [03/21/06
'554 ROA].

1 available and to reconfigure itself to avoid conflicts with other devices. *Id.* at
2 12:66-13:3 (“[T]he nomadic router 10 is passively able to learn how the network is
3 configured and will elect to use an unused IP address. If that IP address does
4 become used by another network device, it will switch over to another, unused IP
5 address.”). Therefore, the term “network configurations” includes IP addresses.

6 **a. Regardless of MAC addresses**

7 The ’554 patent also requires the gateway device to connect to any computer
8 regardless of MAC addresses. A MAC address is a unique identifier that is pre-
9 programmed into every networking device. The network uses MAC addresses to
10 route data, one hop at a time, from the source computer to the destination. The ’892
11 patent – which is incorporated by reference into the ’554 patent – specifically states
12 that the gateway device will “receive all packets regardless of MAC address.” *Id.*
13 at Fig. 9A; *see also id.* at 13:50-57. Therefore, at a bare minimum, the phrase
14 “regardless of network configurations” requires that the gateway provide
15 transparent network access regardless of MAC addresses.

16 Nomadix’s proposal is unjustifiably narrow. Defendants agree with
17 Nomadix that the term “network configurations” includes “network address
18 settings.” To communicate with the network, the source computer would need to
19 know, in the typical Internet context, several key network addresses, including its
20 own IP address, the MAC and IP addresses of the gateway, and perhaps the IP
21 address of the local DNS server. But, the claim is not limited to the typical context,
22 nor is the term “network configurations” so limited. Indeed, the statements made
23 during prosecution impose universal transparency on the claims, requiring that they
24 enable computers to access any network without regard to the protocols used.

25 For all these reasons, the Court should adopt Defendants’ proposal.

26 **5. “network location of the user host device” (’716 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
network location of	connection port through which the user host device	No construction is necessary. However, if the Court is inclined

1	the user host device '716: claim 1	configured with a permanent IP address of the home network accesses the network	to construe the term, Nomadix proposes: a location at which the user host device is connected to the network
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4 The parties dispute the meaning of “network location” and whether the user host device should be construed as a device from the “home” network. The parties also dispute the meaning of “network location” and whether the user host device should be construed as a device configured with the permanent IP address from the device’s “home” network.

5 The construction of “network location” to mean the connection port through which the user host device accesses the network is consistent with both the letter and the spirit of the intrinsic record. The patent’s specification defines the location of the user host device as the specific communication port through which the device connects to the network. For example, in connection with Figure 1, which shows the overall configuration of the claimed system, the patent teaches that the devices “can be plugged into ports that are located in different rooms of a hotel, business, or a multi-dwelling unit,” or alternatively, they “can be plugged into ports in an airport, an arena, or the like.” '716 Patent at 20:3-7, 30:41-45.

6 Nomadix’s reliance on the “network location(s)” recited in specific dependent claims does nothing to change this conclusion. Each of the recited locations is again defined in terms of where the specific port is located. The recited “building” is the building containing the specific port, the recited “floor within a building” is the floor containing the port in question, and so on. Indeed, although not mentioned by Nomadix, claim 33 makes clear that the recited “location” is the specific port, even when there are other ports located in the same room.

7 As for the remainder of Defendants’ construction, claim 1 itself mandates that the user host device must be configured with the permanent IP address of the device’s “home” network. A key limitation of the claim is a “network-packet-

1 translation module,” which modifies packets coming from the user host device to
2 replace the IP address of that device with the IP address of the gateway, and to
3 modify packets bound from the external network to the user host device to replace
4 the IP address of the external network location with the IP address of the gateway.
5 The same configuration is illustrated in Figures 11a and 11b of the patent. This is
6 the technique described above in connection with Nomadix’s Transparent Router
7 technology, and it would be completely unnecessary if the user host device were
8 not configured with a permanent IP address. Accordingly, in light of this intrinsic
9 evidence, a person of ordinary skill in the art would have understood the “user host
10 device” to be configured with a permanent IP address.

11 **6. “external network location” ('716 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
external network location '716: claim 1	location for a network to which the user device is not normally connected and which corresponds to a local internet or IP address that is not the home internet [or IP] address	No construction is necessary. However, if the Court is inclined to construe the term, Nomadix proposes: a network location external to the network location of the user host device

12 The parties’ dispute whether the construction of “external network location”
13 should refer to the IP address of the user device. Defendants’ proposal is consistent
14 with the claim language and the stated purpose of the claimed invention.
15 Conversely, both of Nomadix’s alternate proposals amount to offering no
16 construction at all because, rather than explain the meaning of the disputed terms,
17 they at most rearrange words within the disputed terms.

18 Defendants’ proposed construction is consistent with the meaning of the
19 disputed term read in light of the intrinsic evidence. The claim language plainly
20 states that an “external network location” cannot be one on the user device’s base or
21 “home” network. As discussed above concerning the “foreign” terms, the network
22 translation limitation in the claim would be superfluous if the external network
23 location were not “foreign” to the user device’s current network location. Further,

1 the plain language of the claim shows that IP addresses are critical to defining the
2 external network location. Lastly, contrary to Nomadix's assertions (Op. Br. at 23),
3 the '716 patent claims the same gateway device disclosed in the Transparent Router
4 Patents. '716 Patent at 12:49-57. As such, Defendants' proposed construction is
5 more precise and useful than the one Nomadix proposes ("network location external
6 to the network location of the user device.") *See* Op. Br. at 22-23.

7 **C. The Transparent Billing Patent ('399 patent)**

8 The '399 patent ("Transparent Billing Patent") incorporates by reference all
9 but one of the provisional applications incorporated by reference in the Transparent
10 Redirection Patents and the parent application to the Transparent Router Patents.
11 *See* '399 Patent at 1:7-27, 4:27-32.

12 The Transparent Billing Patent describes a gateway device in connection
13 with a property management system that monitors a user's access and usage of the
14 property's network, *i.e.*, "foreign" network. The patent further describes formatting
15 the access and usage information recorded on the gateway device into call
16 accounting records, the same format used by hotel billing systems to charge guests
17 for telephone calls, thereby eliminating the need for a separate billing format for
18 Internet access. Once properly formatted, the gateway device communicates the
19 formatted record to the attached management system, which determines whether to
20 bill the user based on physical location, network usage, or access to the "foreign"
21 network.

22 The Transparent Billing Patent also describes avoiding the reconfiguration of
23 statically configured computers with IP addresses from a "home" network for
24 access on a "foreign" network. For example, all of the claims require a gateway
25 device to provide access to a "foreign" network without installing "special client
26 software" on the user's computer for managing communication over the foreign
27 network. *See, e.g.*, '399 Patent, Claim 1.

28

1 **1. “billing records” terms (’399 patent)**

2 The terms “call accounting records,” “call accounting record format,”
3 “predetermined protocol” and “predetermined data format,” as used in the claims of
4 the ’399 patent, all refer to particular types of telephone billing records that contain
5 fields corresponding to the amount charged and the phone number called. As
6 Nomadix does not contend that these terms have a commonly understood definition
7 in the art, the specification is the best resource to inform the meaning of the claim
8 terms. *MyMail, Ltd. v. Am. Online, Inc.*, 476 F.3d 1372, 1376 (Fed. Cir. 2007)
9 (“without a meaning apart from the patent,” one should “look to the specification”
10 to construe a claim element).

11 **a. call accounting record / call accounting format**

Claim Term	Defendants' Construction	Nomadix's Construction
call accounting record / call accounting record format '399: claims 6, 20	a [protocol / format] that can be used to organize data related to telephone calls that includes fields corresponding to charged amount and phone number called	a [protocol / format] that can be used to organize data related to telephone calls

12 The parties agree that a call accounting record is a format used to organize
13 data related to telephone calls. The only dispute is whether the call accounting
14 record must include fields corresponding to the charged amount and phone number
15 called, which the specification and prosecution history make clear are required
16 fields for call accounting records. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288
17 F.3d 1359, 1366 (Fed. Cir. 2002). The ’399 patent claims are directed toward
18 integrating a gateway device with a management system at a location, such as a
19 hotel, for automatically billing users for network access. According to the
20 specification, such data is “configured in most respects, identical to information
21 received... from a private branch telephone system (PBX), which are commonly
22 utilized in hotels.” ’399 Patent 7:8-11. Call accounting records (CARs) are one
23 such type of format. *Id.* at 7:53-55. In this way, the same management system that
24 bills guests for telephone calls can also bill for network access using the same call
25
26
27
28

1 accounting data format.

2 Although the precise format of call accounting records varies to some extent
3 depending on the management system, the specification explains that some of the
4 fields in the CAR are optional and can be removed, whereas others are required. *Id.*
5 at 8:49-65. “[W]here the CAR records cannot be replaced, a mock field, such as a
6 mock telephone number, may be included so that the property management system
7 receives the entire record it is programmed to received.” *Id.* at 61-65.

8 During prosecution, Nomadix clearly stated that “charged amount and phone
9 number called” are “required fields of call account records.” Ex. 24 at 10 [11/07/03
10 ’399 ROA] (emphasis added). To overcome an obviousness rejection, Nomadix
11 argued that it would not have been obvious to bill in a situation in which “no phone
12 number exists and/or no ‘call’ is being placed,” such as accessing the Internet. *Id.*
13 According to Nomadix, the “invention... teaches the gateway’s ability to insert and
14 determine a charged amount and phone number called (required fields of call
15 account records), even though a real phone call was not placed nor a phone number
16 available.” *Id.* Nomadix cannot avoid its clear and unambiguous statements in the
17 specification and prosecution history in defining the scope of call accounting
18 records. *Computer Docking Station Corp. v. Dell, Inc., et al.*, 519 F.3d 1366, 1374
19 (Fed. Cir. 2008).

20 Nomadix argues that the Court should simply adopt its construction from the
21 *Second Rule* litigation. But in the *Second Rule* case, neither party cited the
22 prosecution history to support its construction of the “call accounting record” terms.
23 See Exs. 28 at 25-27, 29 at 42-44, 30 at 11-13, 31 at 16-17 (claim construction
24 briefs). The Court did not cite or rely on the prosecution history in reaching its
25 conclusions. See Ex. 32 at 17-19 (*Second Rule* Amended Claim Constr. Order).
26 Therefore, the Court should reexamine its previous construction in light of the
27 prosecution history. Unlike Nomadix’s proposed construction, Defendants’
28 proposed construction is supported by the file history and should be adopted.

b. Predetermined protocol / predetermined data format

Claim Term	Defendants' Construction	Nomadix's Construction
predetermined protocol / predetermined data format '399: claims 6, 13, 18	a [protocol / format] that can be used to organize data related to telephone calls that includes fields corresponding to charged amount and phone number called	No construction is necessary

During prosecution, Nomadix repeatedly characterized the purported invention as not merely utilizing a generic “predetermined” protocol or data format, but call accounting records specifically. Indeed, Nomadix amended certain claims in this regard to overcome prior art. Nomadix should not be allowed assert a broader scope of “predetermined” protocol and data format now that the patents are in litigation.

As originally drafted, claims 1 and 6 formatted data into “one of the predetermined [protocols / data formats] supported by the management system.” The Examiner rejected these claims as anticipated by U.S. Patent No. 5,893,077 (“Griffin”). Nomadix amended the claims to require formatting into “call accounting record format” and distinguished the prior art on this ground, stating that Griffin “does not provide a teaching of formatting data in call accounting record format.” Ex. 25 at 7 [12/09/02 ’399 ROA]. Furthermore, Nomadix made clear that its invention – not just what was described in these particular claims – required call accounting records: “The present invention goes beyond ‘employing such a protocol’; in that, the gateway device receives data from the computer / hosts and formats (or re-formats) the data into call accounting records.” *Id.* at 7 (first emphasis added).

Throughout the prosecution, Nomadix repeatedly emphasized that the “present invention” formats billing data into call accounting records to overcome prior art rejections. For example, after the Examiner rejected a number of the claims as obvious over U.S. Patent No. 5,987,430, Nomadix argued that formatting data into call accounting records would not have been obvious. According to

1 Nomadix,

2 [a]lthough call accounting records are fundamentally based upon calls
3 using phone numbers... phone numbers are not used in
4 Ethernet/Broadband (non-dialup) Internet connections. Such
5 connections are the focus of this invention... The present invention
6 uses special techniques, referred to as location identification to
7 determine where a user's access is coming from and thus who/where
8 should the call account record bill be sent.

9 Ex. 24 at 10 [11/07/03 '399 ROA] (emphasis added). Moreover, Nomadix
10 explicitly stated that this characterization included the claims that used the
11 "predetermined data formats." In the very next paragraph, Nomadix stated that "for
12 the reasons stated above, independent claims 1, 15, and 20" were not obvious, even
13 though claim 20 did not use the term "call accounting records." *Id.* at 11.

14 By clarifying in the file history that the "present invention" is directed toward
15 formatting data into call accounting records, Nomadix limited the scope of
16 "predetermined" protocol and data format to be commensurate with the format of
17 call accounting records. *Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394, 1398-99 (Fed.
18 Cir. 2008) (limiting claim where "the present invention" was repeatedly described
19 to include the limitation). "Predetermined protocol" and "predetermined data
20 format" should be construed consistently across all claims in which they appear to
21 mean the same as "call accounting records" and "call accounting record format."²⁴
22 *NTP*, 418 F.3d at 1293.

23

24

25 ²⁴ Nomadix suggests that the doctrine of claim differentiation precludes this
26 construction in claims 13 and 18. Op. Br. at 42. However, the presumption of
27 claim differentiation can be overcome by disclaimers, such as those found in the
28 prosecution history. *Fantasy Sports Properties, Inc. v. Sportsline.com, Inc.*, 287
F.3d 1108, 1116 (Fed. Cir. 2002) (presumption of claim differentiation overcome
by clear prosecution disclaimer); *see also Curtiss-Wright Flow Control Corp. v.
Velan, Inc.*, 438 F.3d 1374, 1381 (Fed. Cir. 2006) (claim differentiation overcome
by disclosure in specification). Nomadix's disclaimers control here.

2. “physical location” ('399 patent)

Claim Term	Defendants' Construction	Nomadix's Construction
physical location '399: claims 13, 18	communication port through which the user's computer accessed the network	No construction necessary

Nomadix’s argument that the ordinary and customary meaning should apply to the term “physical location” once again ignores Nomadix’s own narrowing statements during prosecution. Nomadix now proposes that a user’s “physical location” is simply “the place at which a user is located.” Op. Br. at 44. However, Nomadix unambiguously disavowed such a broad construction to overcome the cited prior art:

The Examiner cites column 5, lines 21-32 in the Griffin '077 patent to show a teaching of data flowing from [sic] the host/computer to the gateway device including user's location. We do not believe that this passage or any other passage in the Griffin '077 patent teaches a gateway device that has the capability to identify the physical location of the host/computer. Column 5, lines 21-32 teach a gateway device that tracks a user's access frequency to a network cite [sic] or the user's purchasing profile. It does not teach a gateway device that has the capability to identify the port from which a user gains access to the network.

Ex. 25 at 8 [12/09/02 '399 ROA] at 8 (emphasis added). Nomadix also stated that:

[T]he Griffin '077 patent does not provide a teaching of the novel concept in the present invention whereby the gateway device has the capability to identify the physical location of the host/computer, maintain data representing the physical location of the accessing hosts/computers, format this data into a management system compatible format, communicate this formatted data to the management system, which, in turn, uses the physical location data to

1 bill the user accordingly. The present application supports such a
2 teaching beginning at page 8; line 6, which details maintaining port
3 related information at the gateway device.

4 *Id.* at 10 (emphasis added).

5 In each of the above statements, Nomadix distinguished the cited art by
6 limiting the “physical location” of the host/computer to the communication port
7 through which the computer accesses the network. According to the Examiner,
8 Griffin discloses a system for automatically billing a user for access to a computer
9 network, comprising a network gateway device in communication with the
10 computer for maintaining data representative of the user’s access. *See* Ex. 26 at 3
11 [08/27/02 '399 OA]; Ex. 36 at 6:42-57, 7:5-12 [Griffin '077 Patent]. This data
12 included the customer’s address information. *See id.* at 5:21-32. In distinguishing
13 the Griffin patent, Nomadix could have argued that Griffin failed to maintain data
14 representing “the place at which a user is located,” because Griffin merely
15 maintained a billing address and a user might be at a location other than his or her
16 billing address. Instead, Nomadix equated the “physical location” to an actual
17 communication port. Nomadix thus made a clear and unmistakable disavowal of
18 scope during prosecution. *See Purdue Pharma L.P. v. Endo Pharms., Inc.*, 438
19 F.3d 1123, 1136 (Fed. Cir. 2006).

20 Defendants’ construction should be adopted because it reflects the proper
21 meaning of “physical location,” as narrowed by Nomadix during prosecution.

22 **3. “collecting data corresponding to . . .” ('399 patent)**

23 It is necessary to construe the word “collecting” to distinguish claims 6 and
24 18 from other independent claims of the '399 patent that use similar, but
25 significantly different, language. *See, e.g., Seachange Int'l v. C-Cor, Inc.*, 413 F.3d
26 1361, 1368 (Fed. Cir. 2005) (“The doctrine of claim differentiation stems from the
27 common sense notion that different words or phrases used in separate claims are
28 presumed to indicate that the claims have different meanings and scope.”) (internal

1 quotation marks omitted). Claims 1, 10, and 13 all recite a gateway device that
 2 “maintains” data representative of the user’s access, usage, and/or physical location.
 3 By contrast, claims 6 and 18 require that the gateway actively “collect” that data.
 4 Defendants’ construction properly distinguishes “collecting” from “maintaining,”²⁵
 5 using language taken directly from the patent specification.²⁶

Claim Term	Defendants’ Construction	Nomadix’s Construction
collecting data corresponding to the user’s access to said computer network, including a physical location of the user and the user’s network usage, in said network gateway device ’399: claim 18	monitoring and recording “data representative of the user’s access to the computer network,” including a “physical location” of the user and the “user’s network usage”, in said network gateway device	No construction is necessary.

12 By its plain and ordinary meaning, “collecting” data requires more than just
 13 “maintaining” it. Data is maintained simply by recording it. Collecting, on the
 14 other hand, is more than passive retention, connoting the active accumulation of
 15 data. As used in the ’399 patent, “collecting” encompasses both acquisition and
 16 retention, both of which the written description explicitly recognizes. ’399 Patent
 17 at 6:36-48 (“The gateway device can thus monitor and record information...”). The
 18 gateway device monitors the network traffic from the user’s computer to determine
 19 how, when, and where the user is accessing the network. It then records the
 20 information gathered for the management system’s later use. *Id.*

21

22 ²⁵ Claim differentiation is a general canon of claim construction. But the canon
 23 “creates only a presumption that each claim in a patent has a different scope.” See,
 24 e.g., *Fantasy Sports Props., Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1115-16
 25 (Fed. Cir. 2002). This presumption can be overcome by an explicit disclaimer or
 26 by the prosecution history. *Id.* In this case, there is no evidence to override the
 27 presumption that “collecting” and “maintaining” are two different concepts.

28 ²⁶ Nomadix incorrectly suggests that this Court has already determined that the
 word “collecting” does not require construction. Op. Br. at 46. Second Rule had
 proposed a construction for “collecting data corresponding to the user’s access to
 said computer network”: “collecting data corresponding to a user’s access to the
 computer network, including the duration of such access, after such access has
 occurred.” Ex. 29 at 44 [Second Rule Op. Br.]. That proposal only concerned the
 type of data collected, leaving the key term itself (“collecting”) undefined.

1 Nomadix repeated this two-part formulation during the prosecution of the
2 '399 patent. Nomadix stated that "the gateway is able to monitor and track" the
3 user's physical location. Ex. 25 at 6 [12/09/02 '399 ROA] (emphasis in original).
4 Nomadix further argued that "the novel concept of the present invention" was that
5 the gateway could "identify the physical location of the host/computer" and also
6 "maintain data" representing that location, which would ultimately be transmitted to
7 the management system. *Id.* at 10. "Identifying" and "maintaining" is just another
8 way of saying that the gateway device must "monitor and record" the user's
9 physical location.

10 Defendants' proposal honors the difference between "maintaining" and
11 "collecting" in the '399 patent claims themselves and should be adopted.²⁷

12 **4. "management system" ('399 patent)**

Claim Term	Defendants' Construction	Nomadix's Construction
management system '399: claims 6, 13, 18	a management system that is separate from the network gateway device for managing a property's operations and connected to the network gateway device via a physical link	No construction is necessary

17 The fundamental dispute between the parties is whether this phrase needs to
18 be construed at all. Defendants' construction clarifies that the claimed
19 "management system" is separate and distinct from the gateway device but
20 physically connected to the gateway device.

21 The description of the invention supports Defendants' construction.
22 According to the '399 patent specification, "[t]he present invention relates... to
23 network gateway devices communicating with management systems or servers,
24 such as hotel property management systems, to facilitate subscriber management
25 and billing." '399 Patent at 2:45-49. That the "present invention" comprises both a
26 network gateway device and a management system with which the network
27 gateway devices communicate means that the terms refer to separate and distinct

28 ²⁷ Defendants included the longer phrase to clarify that the act of "collecting" must occur "in said network gateway device," as claims 6 and 18 both require.

1 components.

2 The specification describes the gateway device as physically separate from
3 the management system. The specification repeatedly describes the network
4 gateway device as physically connected to the management system through a serial
5 or Ethernet link. *Id.* at 5:21-23 (“According to one aspect of the invention, the
6 gateway device 12 is in direct communication with the management system 56
7 through a serial connection 57.”); 6:6-11 (“Typically, the gateway device 12 is
8 connected via a serial connection 57, Ethernet connection, or LAN to the
9 management system 56. According to one preferred embodiment the gateway
10 device 12 is connected to the management system 56 via a serial interface.”). This
11 is consistent with the preferred embodiment of FIG. 2, in which “the management
12 system 56 can be a property management system located within a hotel.” *Id.* at
13 5:58-60. Although the property need not be a hotel, the management system must
14 be physically connected to the gateway device.

15 **5. “absent additional agents” terms (’399 patent)**

Claim Term	Defendants’ Construction	Nomadix’s Construction
absent additional agents implemented by [the / a user’s] computer ’399: claims 6, 13, 18	without the need to implement additional “agents” or to reconfigure the computer in any manner	Nomadix agrees with the Court’s prior construction: absent additional special client software implemented by the computer for managing the communication between the computer and the gateway device

21 The parties dispute whether the Court’s prior construction for “absent
22 additional agents” sufficiently addresses the substantive dispute in this case: what
23 constitutes an “additional” agent. The ’399 patent, like all of the Nomadix patents,
24 requires a “novel gateway device” that provides transparent network access to
25 computers configured for a home network. Ex. 24 at 9 [11/07/03 ’399 ROA]. In
26 the ’399 patent, this transparency requirement is expressed by the limitation that the
27 gateway device operate “absent additional agents implemented by the computer.”
28

1 '399 Patent, Claim 1. The parties agree that an agent is “special client software for
2 managing the communication between the client and the gateway device.” *See*
3 AJCCS (Dkt. No. 248), Ex. 6 at 55. The only dispute is what constitutes an
4 “additional” agent.

5 An “additional” agent is one that reconfigures the computer. It is undisputed
6 that the user’s computer must have agents installed to communicate with the
7 network. The Nomadix patents assume – and, in many cases, require – that the
8 computer have a web browser. *See, e.g.*, '894 Patent, claims 1, 5, 6. But while the
9 patent allows for some agents, it expressly prohibits the gateway device from
10 relying on other, “additional” agents. It is essential, therefore, to distinguish
11 between permitted, “regular” agents and forbidden, “additional” agents.

12 Defendants’ construction is taken directly from statements made by
13 Nomadix’s during prosecution of the '399 patent. It is supported by the
14 specification of the '894 patent, on which Nomadix relied when amending its
15 claims. It is also consistent with Nomadix’s own claim construction arguments in
16 the *Second Rule* case.

17 First, Nomadix added the “absent additional agents” requirement to
18 distinguish its system from the prior art – specifically, U.S. Patent No. 5,987,430 to
19 Van Horne. Unlike the Van Horne patent, the Nomadix system uses a “novel
20 gateway device” that automatically bills the user “independent of client software or
21 the need to reconfigure the client.” Ex. 24 at 9 [11/07/03 '399 ROA] (emphasis
22 added). Nomadix further explained that the universal gateway device is “highly
23 beneficial” because it frees the user from the burden of having to reconfigure the
24 computer:

25 [T]he user benefits from being able to access networks without having
26 to implement (and store) special client software or reconfigure the
27 computer in any other manner.

28 *Id.* (emphasis added). Defendants’ construction adopts this language verbatim.

1 Second, a proper claim construction should align with the purpose,
2 objectives, and stated benefits of the claimed invention. *See CVI/Beta Ventures,*
3 *Inc., v. Tura LP*, 112 F.3d 1146, 1160 (Fed. Cir. 1997). Nomadix instructed the
4 Patent Office to look to the '892 and '894 patents for an explanation of the key
5 features of its universal gateway device. *Id.* The '894 patent, in particular, explains
6 why a universal network gateway does not require a user to implement “additional
7 agents.” When a computer connects to a traditional gateway, “special software
8 must also typically be loaded onto the user’s computer to support reconfiguration.”
9 '894 Patent at 1:63-65. But a universal gateway device provides transparent access,
10 meaning that “the user need not reconfigure their computer and no additional
11 software need be added to the computer for reconfiguration purposes.” *Id.* at 3:45-
12 48; *see also*, '554 Patent at 10:16-18 (“Furthermore, no additional configuration
13 software will have to be added to the source computer.”). Nomadix has
14 consistently and repeatedly explained that the principal benefit of a universal
15 gateway device is that it eliminates the need for the user to install additional
16 software that reconfigures the computer. Defendants’ construction properly
17 captures this feature of the gateway.

18 Finally, Defendants’ construction is supported by Nomadix’s Reply Claim
19 Construction Brief in the *Second Rule* case. Ex. 30 at 5-8. Second Rule had argued
20 that the word “additional” was surplusage with no limiting effect. Nomadix
21 correctly responded that Second Rule’s position was “untenable” and that the word
22 ““additional” must remain a claim limitation.” *Id.* at 5. Nomadix went on to equate
23 this claim limitation with the ability to connect to the network “without
24 reconfiguration”:

25 [T]he specification explains that if a computer is moved from its home
26 network where it was able to access the Internet to a new network with
27 the patented gateway device, then the computer could connect to the
28 new network without reconfiguration. Even more particularly, the

1 invention facilitates connecting the computer to the new network
2 “without loading any additional software on the computer.”

3 *Id.* at 6-7 (first emphasis added and citations omitted). This is Defendants’
4 argument in a nutshell.

5 In this case, Nomadix never explains what distinguishes an “additional”
6 agent. It has simply inserted the agreed-upon definition of “agent” into the phrase
7 “absent additional agents implemented by the computer,” without addressing the
8 essential issue. The patent’s universal gateway device does not eliminate the need
9 for all agents. It only eliminates the need for agents that reconfigure the user’s
10 computer. Accordingly, the Court should adopt Defendants’ proposed construction.

11 **IV. CONCLUSION**

12 Defendants respectfully submit that their constructions are the proper
13 constructions based on the intrinsic evidence. Defendants’ constructions address
14 the Nomadix workaround as expressed in the claims of the patents. Accordingly,
15 the Court should adopt the Defendants’ constructions.

16

17

18 Dated: April 8, 2011

ORRICK, HERRINGTON & SUTCLIFFE LLP

19

20

/s/ I. Neel Chatterjee

21

I. Neel Chatterjee

22

Fabio E. Marino

23

Monte M.F. Cooper

24

Qudus B. Olaniran

25

Benjamin J. Hofileña

26

Alyssa M. Caridis

27

Attorneys for Defendant and Counterclaimant
IBAHN CORPORATION

28

1 Dated: April 8, 2011

COVINGTON & BURLING LLP

2 */s/ Michael K. Plimack (with permission)*

3 Michael K. Plimack

4 Robert T. Haslam

5 Michael P. Wickey

6 Attorneys for Defendants

7 HEWLETT-PACKARD COMPANY

8 Dated: April 8, 2011

SIDLEY AUSTIN LLP

9 */s/ Lisa A. Schneider (with permission)*

10 David T. Pritikin

11 Hugh A. Abrams

12 Lisa A. Schneider

13 Benedict F. Frey

14 Paul D. Tripodi II

15 Olivia M. Kim

16 Attorneys for Defendant

17 WAYPORT, INC.

18 Dated: April 8, 2011

FENWICK and WEST LLP

19 */s/ Michael J. Sacksteder (with permission)*

20 Michael J. Sacksteder

21 Darryl M. Woo

22 David M. Lacy Kusters

23 Attorneys for Defendants

24 SUPERCLICK NETWORKS, INC. AND

25 SUPERCLICK, INC.

26 Dated: April 8, 2011

WEIL GOTSHAL & MANGES LLP

27 */s/ Nicholas Groombridge (with permission)*

28 Nicholas Groombridge

29 Robert Watkins, III.

30 Attorneys for Defendant

31 ARUBA NETWORKS, INC.

1 Dated: April 8, 2011

REED SMITH LLP

2
3 */s/ David T. Pollock (with permission)*

4 John P. Bovich
David T. Pollock
Michael A. Garabed

5 Attorneys for Defendant
6 SOLUTIONINC TECHNOLOGIES LTD.

7

8

9

10

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